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OFFICE OF PETITIONS

In re Charles J. Zapiec et al.
Application No.: 09/636,448
Filed: August 11 2000
Patent No.: 7,222,293
Issued: May 22, 2007

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: **DECISION DISMISSING**
: **PETITION REQUESTING**
: **CORRECTED PATENT**
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This is a decision on the May 23, 2007 petition titled "Petition Under 37 CFR 1.322(b)" ("the May 23, 2007 petition").

The petition is being treated as a petition under 37 CFR 1.182.¹ A petition fee under 37 CFR 1.17(f) of \$400.00 has been charged to Deposit Account No. 50-1998, as authorized on page 2 of the May 23, 2007 petition.

The May 23, 2007 petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 23, 2007 petition is **DISMISSED**.

PERTINENT STATUTE, REGULATIONS, AND PATENT EXAMINING PROCEDURE

35 U.S.C. 254 provides, in pertinent part:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. ... The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

37 CFR 1.322(b) provides:

If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

¹ 37 CFR 1.322(b) does not provide a petition right.

37 CFR 1.52(a)(1)(iv) provides:

(a) Papers that are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or a reexamination proceeding.

(1) All papers, other than drawings, that are submitted on paper or by facsimile transmission, and are to become a part of the permanent United States Patent and Trademark Office records in the file of a patent application or reexamination proceeding, must be on sheets of paper that are the same size, not permanently bound together, and:

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(iv) Plainly and legibly written either by a typewriter or machine printer in permanent dark ink or its equivalent

MPEP 1309(II) provides, in pertinent part:

The Fee(s) Transmittal form (PTOL -85B) provides a space (item 3) for assignment data which should be completed in order to comply with 37 CFR 3.81. ... Assignment data printed on the patent will be based solely on the information so supplied.

DECISION

The May 23, 2007 Petition is Dismissed

At page 1 of the May 23, 2007 petition, patent owner states: •

An issue fee transmittal ... was submitted by the undersigned on April 12, 2007 for Application No. 09/636,448, which issued as the Patent. On the issue fee transmittal, the name of the assignee of the Patent was listed in Box 3.(A) as "APPLIEDE, INC." However, due to a mistake incurred through the fault of the Office, the Patent was printed with the assignee's name listed as "Applieoe, Inc."

At page 2 of the May 23, 2007 petition, patent owner concludes that "the error and the noted consequences are the direct result of a mistake on the part of the Office such that a certificate of correction is inappropriate in form as unable to overcome the disadvantages suffered by the assignee by having the mistake printed on the front page of the Patent."

35 U.S.C. 254 is titled "Certificate of correction ***of Patent and Trademark Office mistake***" (emphasis added) and is the sole provider of statutory authority for the

Office to issue a corrected patent.² Notably, 35 U.S.C. 255, which is titled "Certificate of correction **of applicant's mistake**" (emphasis added), does not mention a corrected patent.

37 CFR 1.322(b) is the regulation implementing 35 U.S.C. 254; it provides:

If the nature of the **mistake on the part of the Office** is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee. [Emphasis added.]

Thus, issuance of a corrected patent under 35 U.S.C. 254 and 37 CFR 1.322(b) is reserved for certain instances in which the mistake to be corrected in the patent is a mistake on the part of the Office. The Office has no statutory authority to issue a corrected patent for a mistake in a patent that was not a mistake on the part of the Office.

In the present case, the Office has no statutory authority to issue a corrected patent for U.S. Patent No. 7,222,293 ("the '293 patent"), because the May 23, 2007 petition does not establish that it was Office error for the face of the '293 patent to identify "Applieoe, Inc." as the assignee. Specifically, assignment data printed on the face of a patent is based **solely** on the information supplied at item 3 of the Fee(s) Transmittal form (PTOL 85B).³ In addition, all papers submitted by facsimile transmission that are to become a part of the permanent Office records in the file of a patent application must be plainly and legibly written either by a typewriter or machine printer.⁴ The April 12, 2007 Fee(s) Transmittal form (PTOL 85B) in application no. 09/636,448 was submitted via facsimile, and item 3 of the form was completed in handwriting that is not sufficiently plain and legible to distinguish between "Appliede, Inc." and "Applieoe, Inc."

Even if the May 23, 2007 petition had established that it was a mistake on the part of the Office for the face of the 293 patent to identify "Applieoe, Inc." as the assignee, issuance of a corrected patent under 35 U.S.C. 254 and 37 CFR 1.322(b) is reserved for those instances in which the mistake to be corrected in the patent is a mistake on the part of the Office, **and** in which a certificate of correction is deemed inappropriate in form. A certificate of correction is typically appropriate in form where the errors are less than substantially the entire document. In particular, a certificate of correction is the normal mechanism for correcting a patent where, as here, the only identified error in the patent is the name of the assignee on the face of the patent.

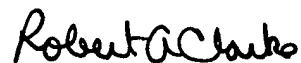
² The last line of 35 U.S.C. 254 states that "[t]he Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction."

³ See: MPEP 1309(II).

⁴ See: 37 CFR 1.52(a)(1)(iv).

For the foregoing reasons, the May 23, 2007 petition requesting the Office to issue a corrected patent for the '293 patent is **DISMISSED**.

Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



Robert A. Clarke
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

the Patent. Many of these potential investors have expressed concern regarding the error in listing the name of the assignee, which as a direct result has caused investment in assignee's company to cease. Prior to issuance of the Patent, some of these investors invested money in the assignee, with promises of larger investments after the issuance of the Patent. None of these previous investors has invested any money in the assignee since the Patent has issued, citing concerns over the mistake in listing the assignee's name on the front page of the Patent as an indication that other problems might exist.

In view of the foregoing, it is respectfully submitted that the error and the noted consequences are the direct result of a mistake on the part of the Office such that a certificate of correction is inappropriate in form as unable to overcome the disadvantages suffered by the assignee by having the mistake printed on the front page of the Patent.

Therefore, it is respectfully requested that this petition be granted, in which case pursuant to 37 CFR 1.322(a) the Director is requested to issue a corrected patent in place of the Patent as a more appropriate form of correction. It is believed that no petition fee is required. However, if such fee is in fact required, please charge the fee to our deposit account, No. 501998, and notify us accordingly.

Respectfully submitted,



May 23, 2007

Date

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